

REMARKS

By this amendment, Applicants have amended claim 5 to depend from claim 1 and have added claims 9-11 to further define their invention. Claims 9-11 are supported by, e.g., Example 2. See, page 12, lines 5-15 and Table 1 on page 13 of Applicants' specification.

In response to the restriction requirement in the outstanding Office Action, Applicants elect, with traverse, the invention of Group I, including claims 1 and 2, drawn to a resin composition.

In response to the election species requirement in numbered Section 2 on page 4 of the Office Action, Applicants elect the species of Example 2. At least claims 1, 2 and 5-11 read the elected species. At least claims 1, 5 and 8 are generic.

The restriction requirement in numbered section 1 of the Office Action is traversed. The Examiner has alleged the inventions of Groups I-IV to be related as mutually exclusive species in an intermediate-final product relationship. This allegation is wrong on both counts. That is, the inventions are not mutually exclusive species and at least inventions I-III are not related in an intermediate-final product relationship.

Inventions I-IV are not mutually exclusive species. Claims are definitions of inventions. Claims are never species. The scope of a claim may be limited to a single disclosed embodiment or a claim may include two or more disclosed embodiments within the breath and scope of the claim (and thus be a generic claim).

Species are always the specifically different embodiments. Manual of Patent Examining Procedure (MPEP) 806.04(e). Where two or more species are claimed,

a requirement for restriction to a single species may be proper if the species are mutually exclusive. Claims to different species are mutually exclusive if one claim recites limitations disclosed for a first species but not a second, while a second claim recites limitations disclosed only for the second species and not the first. This may also be expressed by saying that to require restriction between claims limited to species, the claims must not overlap in scope. (MPEP) 806.04(f). Here, the invention of Group I is generic to the inventions of Groups II and III. Claims 1 and 2, on one hand, are not mutually exclusive to claim 3 or claim 4, on the other hand, since the claims overlap in scope. For example, claim 1 overlaps in scope with claim 3 and overlaps in scope with claim 4.

Put another way, for example, claim 3 reads on Example 3, as does claim 1. Since claims 1 and 3 both read on a single disclosed embodiment, they are not mutually exclusive. Likewise, for example, claim 4 reads on Example 4, as does claim 1. Thus, claims 1 and 4 are not mutually exclusive.

Since the claims are not mutually exclusive as alleged by the Examiner, the restriction requirement must be withdrawn.

Moreover, while the Examiner alleges Groups I-IV to be related in an intermediate-final product relationship, there is no such disclosure with respect to Groups I-III. For example, claims 1 and 3 read on the same product, e.g., Example 3. Claims 1 and 3 are not directed to mutually exclusive species in an intermediate-final product relationship but are claims which merely differ in scope. The same is true with respect to claims 1 and 4. There is no disclosure that a resin composition set forth in claim 1 is made prior to a resin composition set forth in claim 3 or claim 4. Thus, the inventions are not disclosed to be in an intermediate-final product

relationship as alleged by the Examiner. Accordingly, the restriction requirement must be withdrawn for this additional reason.

In view of the foregoing amendments and remarks, examination of all the claims now in the application is respectfully requested.

It is respectfully requested that any shortage in the fee be charged to the deposit account of Antonelli, Terry, Stout & Kraus, LLP, Deposit Account No. 01-2135 (Case: 1021.43550X00).

Respectfully submitted,

ANTONELLI, TERRY, STOUT & KRAUS, LLP



Alan E. Schiavelli
Registration No. 32,087

AES/at
(703) 312-6600
Attachment